

REMARKS

Claims 1-9 and 14-23 remain in this application, with Claim 1 presently amended and new Claims 14-23 added. No new matter has been added by this amendment. Applicants respectfully request review and reconsideration of this application.

New claims 14-23 more particularly claim the Bottle Boot™ bottle holder embodiment of the invention, shown and described in connection with Figs. 1-5 of the present application, and that is within the same species as Claims 4 and 9 elected for examination. The elected species is also presently the Applicant's principal commercial embodiment, as shown in Exhibit H to the Declaration of Richard Umbrell, submitted with Applicant's last response. Claim 1 is generic to this and other embodiments of the invention. Accordingly, if Claim 1 is allowed, Claims 2-10, some of which encompass other embodiments of the invention, should also be allowable.

The Examiner rejected Claims 1, 4 and 9 under 35 U.S.C. § 112, second paragraph, for being indefinite as not clearly pointing out whether or not the vehicle is positively recited. This rejection is respectfully traversed. The amendments suggested by the Examiner have been made to clarify that the vehicle is merely recited functionally. In addition, "connected" has been changed to "assembled" to clarify that a direct structural connection between the recited elements is not required, and Claim 1 is not narrowed thereby. The remaining amendments to Claim 1 are intended for clarification, and should be self-explanatory. Claim 1 is believed to be sufficiently definite, and these rejections should therefore be withdrawn.

In the most recent Office Action, the Examiner withdrew the previous rejection based on Sorth and Wemyss, and rejected Claims 1 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Sorth in view of Duty. These rejections are respectfully traversed.

Sorth discloses a magnetic cup holder "for holding beverage containers while riding in moving vehicles." Col. 1, lines 20-21. Important features of the cup holder

include a leveling mechanism and a notch to accommodate a handle in a coffee mug or the like. Col. 1, lines 24-30. Applicant is not aware of any commercial success enjoyed by Sorth's cup holder, perhaps because magnetic surfaces large enough to support a beverage cup, such as metal dashboards, are not generally found inside of most cars constructed after the 1960's or thereabouts. Therefore, one of ordinary skill would not have considered using a magnetic cup holder around the time of the invention, which was well after the time of metal dashboards. Magnetic cup holders would not work inside modern automobiles, and would not have been needed for the vehicle exterior.

In addition, Sorth fails to disclose or suggest "a cushion assembled to the bottle holder, wherein at least a portion of the cushion is adapted to be positioned between the magnet and the exterior surface of the vehicle when the bottle holder is secured to the exterior surface of the vehicle by the magnet and wherein the cushion is comprised of a material adapted to substantially resist scratching the exterior surface of the vehicle," as defined by Claim 1. Acknowledging these deficiencies of Sorth, the Examiner cites Duty.

Duty discloses a fluorescent work light that is connected via a pair of adjustable pivot arms to a pair of base members (14 and 16), each of which utilizes a magnet (38). Col. 3, lines 7-39. Duty teaches that the "magnet 38 is preferably provided with a cover 42 formed of rubber or other soft material to prevent the magnet from scratching or marring the finish on a car panel." Col. 3, lines 18-21. Duty fails to disclose or suggest any purpose for a magnet other than for holding a work light.

Therefore, one of ordinary skill would not have been motivated to combine a bottle holder adapted to receive a fluid container, a magnet, and a cushion for the magnet as defined by Claim 1, at the time the invention was made. The combination of Sorth was obsolete by that time, and Duty suggests nothing to the contrary.

But even if the Examiner is deemed to have raised a *prima facie* case, the objective evidence of nonobviousness submitted in Applicant's last response, namely, the Declaration of Richard Umbrell and its exhibits, remains equally pertinent to rebut

the pending rejections under 35 U.S.C. § 103(a). The merits of the secondary evidence was not discussed by the Examiner in the last Office Action. Accordingly, the secondary indicia of long-felt need and commercial success of the BottleBoot™ bottle holder, a bottle holder constructed according to this invention, provide objective evidence of non-obviousness that should be deemed to rebut any *prima facie* case raised by the combination of Sorth with Duty or Jasmagy.

For the Examiner's convenience, the Applicant's prior remarks concerning the secondary indicia already of record are substantially repeated below.

As indicated by the Declaration of Richard Umbrell under 37 C.F.R. § 1.132, there has been a long felt need in the automobile reconditioning industry for a storage container for various wax and polish bottles that temporarily attaches to and is easily removed from the exterior of a vehicle and that would not mar the surface of the vehicle. Mr. Umbrell and several of his customers indicated that until the storage container of the present invention was introduced, no storage or attachment device addressed this need of automobile detailers and that they instead would place the bottles on top of the car or beside their feet when working and invariably the bottles would fall, get kicked or roll away. (Umbrell Decl. ¶3, Exh. F,G). Mr. Umbrell further indicated that solutions such as the use of an apron with pockets have been tried to address the problem. Mr. Umbrell stated that this prior art solution was unsatisfactory in that the position of the detailer leaning into the car to buff the surface often caused the squeeze bottle to be pressed between his torso and the car resulting onto excess product being leaked on to already cleaned surfaces of the car. (Umbrell Decl. ¶3) That is, the lack of convenient stowage for product bottles continued after the disclosure of both the magnetic cup holder of Sorth and the magnetic coupler of Wemyss. As further indicated by Richard Umbrell in his declaration and by his customers within the automobile reconditioning industry, the bottle holder produced in accordance with the invention is the first and only product in the industry that solves the problem of where to stow the wax and polish bottles when working on an automobile. (Umbrell Decl. ¶5, Exhs. A,B,C,D,E).

The commercial success, broad industry appreciation and immediate acceptance of the Bottle Boot™ bottle holder, a product produced in accordance with the invention of this application, is further evidence of the non-obviousness of this invention. During the first year this product was on the market, 9,605 units were sold to major distributors of automobile reconditioning products located across the United States. (Umbrell Dec. ¶14). As indicated by Mr. Umbrell, this number of sales for a new product represents a large volume of sales for a small company in the auto reconditioning industry. *Id.* Both the Federal Circuit and district courts have repeatedly noted that commercial success of the commercial embodiment of an invention is uncontroverted evidence of non-obviousness and is entitled to fair weight. See, e.g., *Leviton Mfg. Co. v. Universal Sec. Instruments, Inc.*, 304 F. Supp. 2d 726, 752 (D. Md., 2004) (citing *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1391 (Fed. Cir. 1988)). The commercial success of the Bottle Boot™ bottle holder can be directly attributed to the claimed features of the invention since the only advertising for this product involved sending one sample device to current customers along with a copy of a flyer specifically describing the unique features of the product. (Umbrell Decl. ¶17, Exh. H).

Moreover, the Federal circuit has repeatedly noted that commercial success can be established by customer testimony, and ample customer testimony has been provided here. See, e.g., *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 668 (Fed. Cir., 2000); *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1351 (Fed. Cir., 2000); *Pro-Mold v. Great Lakes Plastics*, 75 F.3d 1568 (Fed. Cir., 1996); *Tate Access Floors Inc. v. Interface Architectural Resources*, 185 F. Supp. 2d 588, 604 (D. Md. 2002). For example, in *Winner Int'l Royalty Corp. v. Wang*, the Federal Circuit affirmed a finding of commercial success based on significant sales in the relevant market and a survey of customers indicating that the patented improvement was the reason they purchased the product. *Winner Int'l Royalty Corp.*, 202 F.3d at 1351. Furthermore, in *Pro-Mold v. Great Lakes*, the Federal Circuit noted that Pro-Mold's lack of previous experience in the relevant market combined with its high sales of the patented product provided an

inference of a nexus between its commercial success and the patented invention and are thus probative evidence of non-obviousness. *Pro-Mold*, 75 F.3d at 1574. Finally, in *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, a district court noted that affidavits from customers insisting on the particular product and noting that dealers were overjoyed by the product provided evidence of a nexus between the claimed invention and the commercial success of the commercial product. *Tate Access Floors, Inc.*, 185 F. Supp. 2d 588, 604 (D. Md. 2002)

Therefore, customer feedback regarding the Bottle Boot™ bottle holder further supports attributing this commercial success to the claimed features of the product. For example, Mr. Carley, an auto reconditioning supplies distributor in New Mexico, stated that the main reason my customers like the Bottle Boot™ bottle holder is “it doesn’t scratch the paint because of the unique rubber bottom.” (Umbrell Decl. ¶11, Exh. E). Mr. Kinzy, owner and president of a car care product supplier in Arizona, applauded the introduction of the Bottle Boot™ bottle holder as the perfect device for consolidating tools necessary for automobile reconditioning, particularly noting the magnetic bottom. (Umbrell Decl. ¶10, Exh. D). Mr. Peterson of Auto Wax Supply, wrote that he “immediately recognized the usefulness of this product [the Bottle Boot™ bottle holder] for my customers” and that what he “especially liked about the bottle boot is that there is a cushion between the magnet and where it attaches to the car.” (Umbrell Decl. ¶12, Exh. F). Mr. Henderson of Southern Detail Suppliers states that he has been selling the Bottle Boot™ bottle holder for about one year and that he has received much positive feedback from his customers regarding the “handiness of the boot for storing their wax and polish bottles at hand while they work on a car...and the fact that it does not mar the surface of the car when it is removed.” (Umbrell Decl. ¶12, Exh. G)

This customer testimony supports the proposition that the commercial success of the product made in accordance with this patent application, i.e. the Bottle Boot™ bottle holder, was a direct result of the features claimed in this application, namely the magnetic bottom, the cushion connected to the magnet and positioned between the

magnet and the exterior surface of the vehicle and the tapered sleeve of the bottle holder. The evidence should therefore be accorded substantial weight. M.P.E.P. § 2144.08 II B. Furthermore, this testimony shows that once introduced to the automobile detailing market, the product made in accordance with the invention of this patent application attained immediate and broad acceptance within the automobile detailing market since the customers represented by these letters include major distributors of automobile cleaning products across the United States with over 79 years combined experience in the industry. (Umbrell Decl. ¶15).

Thus, the long felt, but previously unmet need in the automobile detailing industry along with the commercial success, praise of those skilled in the art, and broad acceptance by the industry of a product made in accordance with the invention described in this patent application compel the conclusion that the Applicants' invention is not obvious.

In view of the foregoing, Applicants respectfully submit it would not have been obvious to combine the teaching of Sorth and Duty to arrive at the invention defined by Claims 1 and 9. These rejections should therefore be withdrawn. Claims 2, 3, and 5-8 depend on Claim 1, therefore they should be allowable for at least the reason that they depend on an allowable base claim. In addition, Claim 14 includes limitations similar to Claim 1 and directed more specifically to the commercial embodiment, i.e., the Bottle Boot™ bottle holder. Sorth and Duty therefore pose no bar to patentability of Claims 14-23.

The Examiner rejected Claim 4 under 35 U.S.C. § 103(a) over Sorth and Duty and further in view of Jasmagy. This rejection is respectfully traversed. Jasmagy does to make up for the deficiencies of Sorth and Duty noted above, and Claim 4 is therefore allowable, at least as depending from an allowable base claim. This rejection should therefore be withdrawn.

In view of the foregoing, reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. To the extent that

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it would be helpful to placing this application in condition for allowance, Applicants encourage the Examiner to contact the undersigned counsel and conduct a telephonic interview.

To the extent necessary, Applicants petition the Commissioner for a three-month extension of time, extending to September 21, 2005, the period for response to the Office Action dated March 21, 2005. The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



Date: September 19, 2005

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